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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,564	05/26/2000	Bradford C Van Wagenen	072827-1002	1913

7590 02/12/2004

RICHARD J. WARBURG  
FOLEY & LARDNER  
402 WEST BROADWAY  
23RD FLOOR  
SAN DIEGO, CA 92101-3542

EXAMINER

JONES, DWAYNE C

ART UNIT	PAPER NUMBER
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1614  
*Renailed*  
DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,564	05/26/2000	Bradford C Van Wagcnen	030591.0009	1913

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03/19/2003

Douglas Murdock  
Brobeck Phleger & Harrison LLP  
12390 El Camino Real  
San Diego, CA 92130

EXAMINER
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JONES, DWAYNE C

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 03/19/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/579,564

Applicant(s)

VAN WAGENEN ET AL.

Examiner

Dwayne C Jones

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1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 77-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 77-86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 77-86 are pending.
2. Claims 77-86 are rejected.

### ***Information Disclosure Statement***

3. The information disclosure statements filed on March 3 2003 has been reviewed and considered because copies of the nonpatent literature were furnished by the applicants, see enclosed copies of PTO FORM 1449.

### ***Drawings***

4. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Claim Rejections - 35 USC § 112***

5. The rejection of claims 77-86 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendment of November 26, 2002.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 77-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harsanyi et al. of U.S. Patent No. 3,262,977. Harsanyi et al. teach of the compounds of general formula (I), (see column 1). These compounds are embraced by the generic definitions that are instantly claimed by applicants. The skilled artisan would have been motivated to select any of the species of the genus taught by the reference because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties as the genus as a whole.

9. Claims 77-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. Walker et al. teach of the compounds of general formulas (III) and (IV), (see page 624-627). These compounds are embraced by the generic definitions that are instantly claimed by applicants. Accordingly, the skilled artisan would have been

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motivated to select any of the species of the genus taught by the reference because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties as the genus as a whole.

10. Claims 77-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi et al. Joshi et al. teach of the compounds of general formula (III), (see page 268 and 271). These compounds are embraced by the generic definitions that are instantly claimed by applicants. For this reason, one having ordinary skill in the art would have been motivated to select any of the species of the genus taught by the reference because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties as the genus as a whole.

### ***Obviousness-type Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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12. Claims 77-86 are again rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,001,884. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the clear overlap in subject matter that exists between that which is currently claimed and the subject matter as claimed in U.S. Patent No. 6,001,884.

13. Claims 77-86 are once again rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-103 of U.S. Patent No. 6,011,068. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the clear overlap in subject matter that exists between that which is currently claimed and the subject matter as claimed in U.S. Patent No. 6,011,068.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (703) 308-4634. The examiner can normally be reached on Mondays through Fridays from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Mondays.

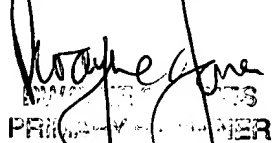
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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WAYNE S. JONES  
PRINCIPAL EXAMINER

Tech. Ctr. 1614

March 17, 2003